

REMARKS/ARGUMENTS

Claims 21-55 are pending in the application, and claims 48-55 are withdrawn from consideration. In an Office Action dated June 22, 2005, claims 21-47 were rejected. In view of the present amendments and the following remarks, the applicant submits that the claims are allowable over the rejections and cited art.

35 U.S.C. §112

The office action initially rejects claims 21-47 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the office action indicates that the “single unit” limitation is not disclosed in the elected Species II of Figure 2. In the Response to Arguments, the office action states that the specification fails to provide proper antecedent basis for the claimed subject matter, in particular the “single unit” limitation.

The applicant respectfully submits that this rejection is improper and should be withdrawn. In particular, Figure 2, which forms a part of the application as filed, discloses a container that comprises a single unit. Nothing in the disclosure indicates that the container of Figure 2 must comprise multiple units or cannot comprise a single unit. Accordingly, the applicant respectfully submits that this rejection is improper and should be withdrawn.

The office action further indicates that the specification teaches away from the “single unit” at page 15, line 1+. Even assuming that this characterization is accurate, the office action does not indicate the significance of this observation. “Teaching away” pertains to an obviousness analysis under §103, but the office action provides no indication of the relevance of this observation under §112. As described above, the application provides adequate support for the “single unit” limitation under §112 to provide antecedent basis; accordingly, the objection should be withdrawn.

Rejections under 35 USC § 102(b)

The “Bennet” reference:

Claims 21-23, 27-32, 36, 38-42, and 46 were rejected as being anticipated by “Bennet”. The office action does not provide any further identification of “Bennet”. Without further identification of the reference, the applicant cannot adequately respond to the office action. The applicant respectfully requests identification of “Bennet”. Further, the applicant respectfully submits that any further rejections of the claims based on “Bennet” should not be made final until the applicant is provided an opportunity to analyze the propriety of such rejections and respond.

“Bennet” may refer to U.S. Patent No. 5,762,145, issued June 9, 1998 to Bennett (“the ‘145 patent”). This reference, however, was cited in the office action dated December 1, 2004, and does not constitute a new reference. Those rejections were addressed in the response filed by the applicant on June 1, 2005.

Assuming that the present office action again refers to the ‘145 patent, the applicant traverses the rejections and re-asserts the comments and arguments previously presented. In particular, the previous response stated that the ‘145 patent discloses a hollow panel with an extinguishant sealed inside. The ‘145 patent does not, however, disclose a container that is a single unit configured to conform to a surface of and at least partially enclose the hazardous material container as required by claims 21, 30, and 40. Figure 4 of the ‘145 patent may disclose a partially enclosed container, but the enclosure is not a single unit conforming to a surface of and at least partially enclosing the container.

These arguments were previously presented were not addressed in the present office action. The applicant respectfully submits that if the rejections based on the ‘145 patent are to be maintained, the rejections should not be made final until the arguments have been properly addressed and the applicant given an opportunity to respond.

In the present office action, claims 21-23, 27-32, 36, 38-42, and 46 stand rejected as being anticipated by “Bennet”, which the applicant assumes, for the purposes of this response, to refer to the ‘145 patent. The office action merely states that Bennet discloses a hazardous

control system comprising a hazard control material 5, a shatterable single container 1 that conforms to the fluid line of the fuel tank that protrudes through holes 7, and a container formed by two single face sheets 2. The office action provides no further analysis to support the rejections of the sixteen rejected claims.

The applicant respectfully traverses these rejections. To support a rejection under § 102, a prior art reference must disclose each and every element and limitation in the rejected claim. Omission of any claimed element or limitation, no matter how insubstantial, is grounds for traversing a rejection based on §102.

In the present application, claim 21 calls for a shatterable container containing the hazard control material, wherein the shatterable container is a single unit configured to conform to a surface of and at least partially enclose the hazardous material container. Claim 30 requires a shatterable container containing the hazard control material, wherein the shatterable container is a single unit and includes at least one surface substantially conforming to a surface of and at least partially enclosing the housing. Claim 40 requires providing a shatterable container comprising a single unit, and at least partially enclosing the housing within the shatterable container.

The '145 patent fails to disclose at least one element of each and every claim. For example, the cited portions of the '145 patent do not disclose, and the office action fails to identify in the '145 patent, a container that is a single unit configured to conform to a surface of and at least partially enclose the hazardous material container as required by claims 21, 30, and 40. On the contrary, the cited portions of the '145 patent disclose a panel that lays flat against a housing, which neither conforms to the surface nor at least partially encloses the housing.

The office action provides no support or explanation for the rejections of the dependent claims. The '145 patent fails to disclose various elements and limitations of the dependent claims, such as shatterable container configured to conform to a fluid reservoir (claim 22), a shatterable container that substantially surrounds the housing (claim 28), and a shatterable container substantially covering at least one of the housing interior surface and the housing exterior surface (claim 29). The applicant submits that the office action does not adequately support the rejections of the dependent claims. Therefore, the rejections of claims 21-23, 27-32, 36, 38-42, and 46 as being anticipated by the '145 patent are improper and should be withdrawn.

The Adams reference:

Claims 21-23, 27-32, 36, 38-42, and 46 stand rejected as being anticipated by U.S. Patent No. 4,763,731 to Adams. To support the rejections of all sixteen claims, the office action simply states that the Adams reference discloses a hazardous control system comprising a hazard control material 14 and the shatterable single container 12 (column 4, lines 40+) that conforms to the fluid reservoir (column 2, lines 41+).

The applicant respectfully traverses the rejections based on the Adams reference. The cited portions of the Adams reference disclose multiple extinguishant containers that are small enough and introduced in sufficient numbers to conform to the shape of an interior space. The cited portions of the Adams reference, however, do not disclose a shatterable container that is a single unit configured to conform to a surface of and at least partially enclose the hazardous material container as required by claim 21. Likewise, the multiple small containers disclosed in the Adams reference do not anticipate a shatterable container that is a single unit and includes at least one surface substantially conforming to a surface of and at least partially enclosing the housing as required by claim 30. Claim 40 requires providing a shatterable container comprising a single unit, and at least partially enclosing the housing within the shatterable container, which is also not anticipated by the multiple small containers of the Adams reference. On the contrary, the cited portions of the Adams reference disclose small containers, each of which appears to enclose nothing but extinguishant. Further, the cited portion of the Adams reference indicates that a body of multiple containers may substantially conform to the shape of an interior space, which teaches away from a single unit including at least one surface substantially conforming to a surface of a housing.

The office action also provides no support or explanation for the rejections of the dependent claims. The Adams reference fails to disclose various elements and limitations of the dependent claims, such as a shatterable container that substantially surrounds the housing (claim 28) and a shatterable container substantially covering at least one of the housing interior surface and the housing exterior surface (claim 29). The applicant submits that the office action does not adequately support the rejections of the dependent claims. Therefore, the rejections of claims

21-23, 27-32, 36, 38-42, and 46 as being anticipated by the '145 patent are improper and should be withdrawn.

Rejections under 35 USC § 103

“Bennet” or Adams in view of Johnson:

Claims 24, 26, 33, 35, 37, 43, 45, and 47 stand rejected as being obvious in view of the “Bennet” and Adams references in view of U.S. Patent No. 1,489,703 to Johnson (“the Johnson reference”). The office action asserts that the Johnson reference discloses a shatterable container having an outer layer first material of thin impervious material and an inner layer of second material having a plurality of scorings. The office action asserts that the Adams reference thus discloses each and every element of claims 24, 26, 33, 35, 37, 43, 45, and 47, that is not disclosed in the “Bennet” and Adams references.

The applicant respectfully traverses these rejections. Rejections under §103 should include the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate; the difference or differences in the claim over the applied reference(s); the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. MPEP 706.02(j). The present office action, however, fails to identify the teaching of the prior art upon which the rejections rely, as well as an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

As described above, the '145 patent and the Adams references fail to disclose several elements of the claimed invention. The cited references therefore do not disclose the elements and limitations of the claims. Thus, the rejections are improper and should be withdrawn.

Further, the Johnson reference does not support the position asserted in the office action. For example, claims 24, 33, and 43 require a shatterable container including a first material and a second material, wherein the first material has a different brittleness than the second material.

Even assuming the characterization of the Johnson reference is correct, a first material of thin impervious material and an inner layer of second material having a plurality of scorings discloses nothing relating to the relative brittleness of the materials. The cited portion of the Johnson reference does not appear to refer to brittleness at all. Without some reference to the respective brittleness of each material, the applicant respectfully submits that it is improper to conclude that the Johnson reference discloses the claimed elements and limitations.

Moreover, claims 37 and 47 require a shatterable container including a surface having a scoring. The Johnson reference, however, discloses a disintegrating container, for example made of paper (page 1, lines 35-37), having staggered slits. The Johnson reference is configured to disintegrate (page 2, lines 3-7), not shatter, in response to an explosive charge (page 1, lines 50-54). The Johnson reference actually teaches away from a shatterable container, as a shatterable container would generate shrapnel that would potentially be more harmful than the original fire.

In addition, claims 26, 35, and 45 require scoring coincident with or along a movement path for a breaking element. Nothing in the '145 patent, the Adams reference, or the Johnson reference discloses a breaking element of any sort, and the office action provides no indication regarding where a breaking element may be disclosed in the pertinent references.

Thus, the office action does not demonstrate all the elements of a prima facie case for obviousness. The cited references do not disclose all of the claim limitations. Further, the office action does not identify a scientifically valid reason to combine was not provided; the prior art must provide a reason, suggestion, or motivation for combining the teachings of the references to produce the claimed invention. To the extent the office action relies on "common knowledge" in the rejections of the claims, the applicant traverses these findings and requests adequate evidence to support them in accordance with MPEP 2144.03. Accordingly, the applicant submits that the rejections of claims 26, 35, and 45 are improper and should be withdrawn.

"Bennet" or Adams in view of Crouch:

Claims 25, 34, and 44 stand rejected as being obvious in view of "Bennet" or Adams in view of Crouch. Claims 25, 34, and 44 call for a breaking element disposed adjacent the shatterable container such that the breaking element breaks the shatterable container when a

movement of the hazardous material container or housing moves the breaking element by a selected amount relative to the shatterable container. According to the office action, the Crouch reference discloses a shatterable container and a breaking element for breaking the container. Even if this characterization of the Crouch reference is assumed to be accurate, the Crouch reference fails to disclose the elements and limitations of the rejected claims. For example, the Crouch reference does not disclose that the hazardous material container or housing moves the breaking element by a selected amount relative to the shatterable container to shatter the shatterable container. Instead, the breaking element of the Crouch reference moves due to sudden acceleration of the system. The mere mention of a breaking element does not disclose each element and limitation of the claimed system. Accordingly, the rejection of these claims is inappropriate and should be withdrawn.

Thus, the office action does not demonstrate all the elements of a prima facie case for obviousness. The cited references do not disclose all of the claim limitations. Further, the office action does not identify a scientifically valid reason to combine was not provided; the prior art must provide a reason, suggestion, or motivation for combining the teachings of the references to produce the claimed invention. To the extent the office action relies on "common knowledge" in the rejections of the claims, the applicant traverses these findings and requests adequate evidence to support them in accordance with MPEP 2144.03. Accordingly, the applicant submits that the rejections of claims 26, 35, and 45 are improper and should be withdrawn.

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Serial No. 09/920,179
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CONCLUSION

In sum, the applicant respectfully submits that all claims are patentable over the cited references and are in condition for allowance. If there are any questions or concerns, please contact the undersigned at the telephone number indicated below.

Date: _____

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